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| 10/597,703 | 08/04/2006 | Stanley George Bonney | PB60733-G USW | 5184 |
| 23347 7590 07/21/2009 GLAXOSMITHKLINE CORPORATE INTELLECTUAL PROPERTY, MAI B482 FIVE MOORE DR., PO BOX 13398 RESEARCH TRIANGLE PARK, NC 27709-3398 | | | | |
| EXAMINER CAMPBELL, VICTORIA P | | | | |
| ART UNIT 3763 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USCIPRTP@GSK.COM

LAURA.M.MCCULLEN@GSK.COM

JULIE.D.MCFALLS@GSK.COM

Office Action Summary

Application No.

10/597,703

Applicant(s)

BONNEY ET AL.

Examiner

VICTORIA P. CAMPBELL

Art Unit

3763

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-18,21-27,29-40,42,43,45 and 46 is/are rejected.
- 7) ☒ Claim(s) 2,19,20,28,41 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/4/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is the initial Office Action based on the 10/597703 application filed August 4, 2006.

Claims 1-46 as presented in the preliminary amendment are currently pending and considered below.

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3-18, 21-27, 29-40, 42, 43, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,085,351 to Martin.

Regarding the above claims, Martin teaches a fluid dispenser having a storage chamber (20, 22) for storing a fluid product; a dispensing outlet (46); a metering chamber (62a, 62b, 62c, and portion enclosed by 34, 37, and 52) having an outlet (56) which places the metering chamber in fluid communication with the dispensing outlet, a transfer opening (72) through which the fluid product is transferable between the storage and metering chambers; and a boundary wall structure which is cyclically movable between a first configuration wherein the transfer opening is open and a second configuration in which the transfer opening is closed, each cycle of movement resulting in a metered volume of fluid product being transferred from the storage chamber to the metering chamber (Fig. 1) and dispensed from the dispensing outlet via the outlet (Fig. 2); and an actuation mechanism (16) actuatable by the user to cause a cycle of movement of the boundary wall structure, adapted to dispose the boundary wall

structure in the second configuration at the end of each cycle of movement caused thereby (the cycle of movement begins with the restoration of position 1 as shown in Figure 1, and then continues with compression to Figure 2 as shown).

Martin fails to explicitly teach or disclose multiple transfer ports. It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the transfer ports, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Martin further teaches that the first and second configurations are expanded and contracted, respectively, that the metering chamber defines a first internal volume in the expanded configuration and a second smaller volume in the contracted configuration (see Figures 1 and 2), and that the second volume is substantially zero.

Furthermore, Martin teaches that the boundary wall has first and second structures, movable relative to one another, the second wall structure ((37, 50, 52, 24 and 30) being disposed in a first position relative to the first wall structure (42, 60, 68) in the first configuration (Fig. 1) and in a second position relative to the first wall structure in the second configuration (Fig. 2), the second position being closer to the first wall structure than the first. Martin also teaches that the first and second wall structures bear against each other in the second configuration (Fig. 2), that the outlet is provided in the first wall structure (56) and the transfer opening is provided in the second wall structure (72), that the first wall structure covers the transfer opening in the second position (70 into 72; see Fig. 2), that the outlet is provided in a section of the first wall

structure against which the second wall structure bears when in the second position (50 and 52 constantly bear on 42), that the first and second wall structures are nestable in the second position (Fig. 2), that the first and second wall structures are movable relative to one another in a forward-rearward direction (Figs. 1 and 2), that the second wall structure forms a rear end of the metering chamber (wall created by lips 72), that the first wall structure forms a forward end of the metering chamber having the outlet therein, that the first wall structure has a side section (42) upon which the second wall structure is sealingly, slidably disposed (50 and 52), that the side section extends forwardly from the forward end (Fig. 1), and that the second wall structure is presented by a plunger-like member (60).

Martin further teaches a one-way valve positioned in the outlet in the dispensing direction (56, 50, 52) which permits fluid to flow only in the dispensing direction. Furthermore, Martin teaches that the actuation mechanism is manually operable, having an operating member which is engagable by a user to actuate the actuation mechanism (16), wherein the operating member is finger-operable, and that the actuation mechanism is actuated in response to depression of the operating member into the dispenser. Martin also teaches that the actuation mechanism is moved from a rest condition (Fig. 1) to an actuated condition on actuation thereof, that the dispenser has a biasing structure (74) which biases the actuation mechanism to the rest condition, and that the biasing structure biases the operating member outwardly.

Martin also teaches that the dispensing outlet as a nozzle adapted for insertion into a nostril (Col. 1, lines 18-19) and that the dispenser is hand-held. Martin also

teaches that when the boundary wall structure is moved in a first phase from the second configuration to the first configuration, the metered volume is transferred to the storage chamber (Fig. 2 to Fig. 1) and when the boundary wall structure is returned to the second configuration in a second phase, the metered volume is dispensed from the dispenser (Fig. 1 to Fig. 2). Further, Martin teaches that an excess volume of fluid product, comprising a metered volume and a surplus volume, is transferred to the metering chamber and a bleed arrangement (72) is further provided to bleed the surplus volume from the metering chamber such that only the metered volume is dispensed. Martin further teaches that the excess volume is transferred in the first phase and bled in the second phase (Figs. 1 and 2), and that the bleeding arrangement is configured to bleed the surplus volume back into the storage container via the transfer opening.

Furthermore, Martin teaches that the metering chamber has an inlet port (72) through which the metering and storage chambers are able to be placed in fluid communication and an inlet valve mechanism (70) associated with the inlet port for selectively opening and closing the inlet port (Figs. 1 and 2), wherein the inlet valve mechanism opens the inlet port when the chamber moves from the second to first configuration. Martin further teaches that the inlet valve mechanism opens the inlet port in an initial phase of movement from the second to first configuration, and that upon opening the inlet port, the open inlet port is the sole flow path for the fluid product from the storage chamber to the metering chamber (Fig. 1). Martin further discloses that the dispenser unit (10) has a dispensing outlet (46) through which the metered volume is dispensed to the external environment.

Martin also teaches a fluid dispenser having a storage chamber (20, 22) for storing a fluid product; a dispensing outlet (46); a metering chamber (62a, 62b, 62c, and portion enclosed by 34, 37, and 52) having an outlet (56) which places the metering chamber in fluid communication with the dispensing outlet, a transfer opening (72) through which the fluid product is transferable between the storage and metering chambers; and a boundary wall structure which is cyclically movable between a first configuration and a second configuration wherein an excess volume of fluid comprising a metered volume and a surplus volume is transferred to the metering chamber from the storage chamber via the transfer opening and the metered volume of fluid product being dispensed from the dispensing outlet via the outlet (Fig. 2); and a bleed arrangement (72) adapted to bleed the surplus volume from the metering chamber so that only the metered volume is dispensed. See above notes on the plurality of transfer openings.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-46 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-24, 36-69, 85, and 92 of copending Application No. 10/597678, claims 1-22, 34-69, 83, and 90 of copending Application No. 10/597683, claims 1-37 of copending Application No. 10/597692, claims 1-24, 36-69, 85, and 92 of copending Application No. 10/597624, and claims 1-25, 37-71, 85, and 92 of copending Application No. 10/597690. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the above applications claim in some combination a fluid delivery device having a storage and a metering chamber wherein the metering chamber is comprised of two members in slideable, sealing engagement for measuring out an excess volume of product, bleeding the surplus volume of product, and delivery of the metered dose through an outlet.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

8. Claims 2, 19, 20, 28, 41, and 44 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA P. CAMPBELL whose telephone number is (571)270-5035. The examiner can normally be reached on Monday-Thursday, 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victoria P Campbell
Examiner, AU 3763

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/Nicholas D Lucchesi/

Supervisory Patent Examiner, Art Unit 3763